

REMARKS/ARGUMENTS

Status of the Claims

Claims 1-16, 19-32, and 35-42 are pending. Claims 2-4, 6-7, 9, 21-22, 24, 33-36, 38, and 40-42 are canceled without prejudice. Claims 43-47 are newly presented. Claims 1, 5, 8, 10, 12 -16, 19, 20, 23, 25, 26, 28, 30, 31, 37, and 39 would be amended. After entry of these amendments, claims 1, 5, 8, 10-16, 19-21, 23, 25-32, 37, 39, and 43-47 would be pending.

Response to the Restriction Requirement

Without acquiescing as to the merits of the Supplemental Restriction Requirement, Applicants with traverse elect species as required for each of Formulae I-V. The required elections are set forth in the following Table. Applicants' election is made with traverse as examination of the subject matter recited in these formulae would not place a substantially greater burden on the Examiner.

Formula	Elected Species	Support is found <i>inter alia</i>
Formula I	Elected cannabinoid compound is arachidonylethanolamide (anandamide)	see original claim 19
Formula II	Elected cannabinoid compound is arachidonylethanolamide (anandamide)	see original claim 19
Formula III	Deleted formula III; claim only recites 2-arachidonylglycerol	see page 8, last line
Formula IV	Elected compound is 4-((hydroxyphenyl)-arachidonamide	See original claim 20
Formula V	palmitylsulphonylfluoride	See original claim 21

Applicants further note that as stated in MPEP § 809.02(a), “[u]pon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR § 1.141.”

Status of the Specification

The specification would be amended to recite compounds as taught in U.S. Patent No. 5,631,297 (enclosed).

Support for the Amendments to the Specification

With respect to the written description requirements of 35 U.S.C. §112, the subject matter of the added text was incorporated by reference in the instant application at p. 15, first sentence, last full paragraph by operation of the last paragraph of the specification at page 43. This subject matter is described in the '297 patent at col. 5, lines 10-30. The non-limiting examples are set forth in the '297 patent over cols. 5-8.

According to MPEP §2163.07, "[m]ere rephrasing of a passage does not constitute new matter. Accordingly a rewording of a passage where the same meaning remains intact is permissible." Thus, the present rephrasing of the original text of the '297 patent to distinguish the "R" substituents as defined in the '297 patent from the "R" substituents as defined in the instant application does not constitute new matter.

Pursuant to 37 CFR §6.19, Applicants provide herewith a declaration signed by the inventor stating that the amendatory matter which has been so paraphrased consists of the same matter incorporated by reference in the parent application.

Applicants believe the above amendments to the specification present no new matter and respectfully request their entry.

Support for the Amendments to the Claims

Each of the claims was amended to place in subscript format any digit referencing a particular substituent.

Each of the claims was amended to indicate that n is an integer.

Claims 1, 5, 14, 15, 16, and 37 were amended to set forth CB1 cannabinoid receptor agonist subject matter. Support for this subject matter is found in the specification *inter alia* at p. 20, lines 2-20.

Claim 8 was amended to recite 2-arachidonylglycerol in place of Formula III.

Claim 10 was amended for purposes of economy. Support for the amendments is found in the previous version of the claim.

Claim 13 was amended to set forth the proper Markush group format and correct a typographical error. Support for the amendments is found in the previous version of the claim.

Claims 14-16 were amended to each set forth CB1 cannabinoid agonists of Formula I. Support for this subject matter is found in the previous version of the claim.

Claim 19 was amended to update an antecedent basis. Support is found in the previous version of the claim.

Claims 23 was amended to set forth the formula as recited therein. Support is found in the previous version of the claim.

Claim 25 was amended to change its dependency from canceled claim 22 to claim 16. Support is found *inter alia* in the previous version of the claim.

Claims 23 and 31 were amended to set forth a formula as respectively recited therein. Support is found in the previous version of the respective claims. Claim 31 was further amended to recite "clinically insignificant dysphoric side effects." Support for this subject matter is found in the specification at p.4 last sentence of the first paragraph. Claim 31 was further amended to set forth that the cannabinoid is formulated for localized delivery to the upper airways. Support for this subject matter is found in the specification *inter alia* in the Abstract and original claim 1.

Claim 37 was amended to set forth heterocyclic ring subject matter. Support for this subject matter is found *inter alia* in the previous version of the claim. Support for the subject matter wherein R₂ is OH and X is NH is found *inter alia* in original claim 3.

Claim 39 was amended to depend from claim 37 and to delete the recital of "2-oxazolidinone." Support for this subject matter is found *inter alia* in the previous version of the claim.

New claim 43 depends from claim 1 and sets forth subject matter from the '297 patent and which was originally incorporated by reference and is now added by amendment. Support is found *inter alia* in the newly added paragraphs to the specification.

New claim 44 depends from claim 1, and sets forth ethanolamide subject matter. Support for such subject is found *inter alia* in original claim 19 which lists a number of ethanolamides.

New claim 45 and 46 depends from claim 1 and 5 respectively. Support for their subject matter is found *inter alia* in original claim 19, and in original claims 1 and 5, respectively.

New claim 47 sets forth selective CB1 agonist subject matter. Support for such subject matter is found in the specification *inter alia* at p. 20, lines 2-20 and over pages 22-25.

Additionally, various claims were amended for purposes of clarity.


In view of the above, Applicants believe the amendments to the claims introduce no new subject matter and respectfully request their entry.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for examination. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,


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